

## REMARKS

All issues originally raised in the Office Action mailed August 5, 2003 are addressed herein. In addition, all issues raised in the Office Action mailed January 17, 2004 are also addressed herein. Of particular note is that remarks regarding how Claims 3, 7, 12, 14, and 16 distinguish over the prior art are included in this response.

Again, the Examiner is thanked for the performance of a thorough search. Applicants note with appreciation that the Examiner has indicated that Claim 11 is allowable if rewritten in independent form.

By this amendment, Claims 7, 25, and 39 have been amended. No claims have been added or deleted. Hence, Claims 1-42 are pending in this application. The amendments to the claims do not add any new matter to this application. Furthermore, the amendments to the claims were made to improve the readability and clarity of the claims and not for any reason related to patentability.

### 1. REJECTION OF CLAIMS 1-10 and 12-18 UNDER 35 U.S.C. § 102(e)

Claims 1-10 and 12-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Whitmarsh*, U.S. Patent Application No. US 2002/0101608. It is respectfully submitted that Claims 1-10 and 12-18, submitted herein, are patentable over *Whitmarsh* for at least the reasons provided hereinafter.

**A. CLAIM 1**

Applicant notes that the Office Action interpreted the first, second, and third paper sources, that are recited in Applicant's Claim 1, as not necessarily referring to different paper sources. Additionally, the Office Action interpreted the first, second, and third page ranges, that are recited in Applicant's Claim 1, as not necessarily referring to different page ranges. Applicants believe that the denotation of first, second, and third paper sources and page ranges clearly indicates that the sources are different and the ranges are different. However, in light of the rejection, Applicants have amended Claim 1 so that it further emphasizes that different paper sources and different page ranges are recited. Therefore, Claim 1, as previously amended, recites the following method:

“A method for printing an electronic document, the method comprising:

selecting a first paper source for printing a first page range of one or more pages of said electronic document;

selecting a second paper source for printing a second page range of one or more pages of said electronic document, wherein said second paper source is a paper source different from said first paper source and wherein said second page range is a page range different from said first page range;

selecting a third paper source for printing a third page range of one or more pages of said electronic document, wherein said third paper source is a paper source different from said first paper source and different from said second paper source and wherein said third page range is a page range different from said first page range and different from said second page range; and

transmitting, to a printing device, information that identifies said first, second and third paper sources for printing said first, second and third page ranges of one or more pages of said electronic document.”

The rejections were based on an interpretation of Claim 1 under which the first, second, and third paper sources were the same, and under which the first, second, and third page ranges were the same. However, Claim 1 as previously amended cannot be

interpreted so broadly. Thus, it is respectfully submitted that Claim 1 overcomes the rejection. In particular, Claim 1 includes several limitations that are not taught or suggested by *Whitmarsh*. Specifically, Claim 1 requires:

“selecting a second paper source for printing a second page range of one or more pages of said electronic document, wherein said second paper source is a paper source different from said first paper source and wherein said second page range is a page range different from said first page range;

Additionally, claim 1 requires:

“selecting a third paper source for printing a third page range of one or more pages of said electronic document, wherein said third paper source is a paper source different from said first paper source and different from said second paper source and wherein said third page range is a page range different from said first page range and different from said second page range” and

These limitations, among others, are not taught or suggested by *Whitmarsh*.

*Whitmarsh* merely teaches the selection of a single paper source/characteristic and the selection of a single page range. See Office Action at page 3, as well as Figures 7 and 9 of *Whitmarsh* (showing a screen with fields for selecting a single paper source or a single page range). *Whitmarsh* does not teach selecting first and second paper sources or first and second page ranges, as claimed in claim 1.

It is therefore respectfully submitted that one or more limitations of Claim 1 are not taught or suggested by *Whitmarsh*. Therefore, *Whitmarsh* does not anticipate Claim 1.

**B. CLAIMS 3, 12, 19, 21, 30, 37, 38, and 40**

Applicant notes that independent Claims 3, 12, 19, 21, 30, 37, 38 and 40 were amended in a manner similar to Claim 1, so that Claims 3, 12, 19, 21, 30, 37, 38 and 40 further emphasize that the paper sources and page ranges recited are different.

It is therefore respectfully submitted that Claims 3, 12, 19, 21, 30, 37, 38 and 40 each include one or more limitations that are not taught or suggested by *Whitmarsh*. Therefore, *Whitmarsh* does not anticipate Claims 3, 12, 19, 21, 30, 37, 38 and 40.

**C. CLAIM 7**

Claim 7, as amended, requires

“displaying a user interface that identifies a set of one or more media types that are available to a printing device for printing pages of the electronic document;” (Underlined text indicates an amendment to the claim submitted herewith).

The cited sections of *Whitmarsh* teach providing user interfaces that display printing options. In *Whitmarsh*, all of the printing options are static and are stored in a printer driver or other similar file on client computer 12. The only time these print options are modified is when the printer driver is updated. The device of *Whitmarsh* has no mechanism for determining what media types are *actually* available on the printer at the time the user interface is displayed. Therefore, it is respectfully submitted that *Whitmarsh* does not teach or suggest: “displaying a user interface that identifies a set of one or more media types that are available to a printing device for printing pages of the electronic document,” as recited in Claim 7.

For example, if a printing device of *Whitmarsh* has a tray that can hold 8.5x11 paper, *Whitmarsh* discloses no way of determining and displaying on any of its user interfaces whether there is actually any paper in that tray.

It is therefore respectfully submitted that Claim 7 includes one or more limitations that are not taught or suggested by *Whitmarsh*. Therefore, *Whitmarsh* does not anticipate Claim 7.

#### **D. CLAIM 14**

Claim 14 requires the step of:

“transmitting to a printing device a request from a client for delivery of a set of print attributes that are available for printing said electronic document on said printing device;”

The cited sections of *Whitmarsh* include text referring to “page 7 at element 72”. It is believed that this statement is referring to “Figure 7 at element 72”, and the remarks herein reflect this.

The cited sections of *Whitmarsh* teach providing user interfaces that display printing options. Printing options in *Whitmarsh* are static and are stored in a printer driver or other similar file on client computer 12. The only time these print options are modified is when the printer driver is updated on client computer 12. *Whitmarsh* does not teach “transmitting to a printing device a request from a client for delivery of a set of print attributes that are available for printing said electronic document on said printing device.” Therefore, it is respectfully submitted that Claim 14 includes one or more

limitations that are not taught or suggested by *Whitmarsh*. Therefore, Whitmarsh does not anticipate Claim 14.

**E. CLAIMS 16**

Claim 16 requires the step of

“transmitting, to a client, said user interface data for displaying the set of print attributes that are available for printing said electronic document on said printing device.”

The cited sections of *Whitmarsh* teach providing user interfaces that display printing options. In *Whitmarsh* all of the printing options are stored in a printer driver or other similar file on client computer 12. The only time these print options are modified is when the printer driver is updated. Nowhere in *Whitmarsh* are “print attributes that are available for printing” transmitted to a client. Therefore, *Whitmarsh* could not possibly teach “transmitting, to a client, said user interface data for displaying the set of print attributes that are available for printing said electronic document on said printing device.”

Therefore, it is respectfully submitted that Claim 16 includes one or more limitations that are not taught or suggested by *Whitmarsh*. Therefore, Whitmarsh does not anticipate Claim 16.

**F. CLAIMS 2, 4 - 6, 8-10, 13, 15, and 17 - 18**

Claims 2, 4 - 6, 8-10, 13, 15, and 17 – 18 all depend directly or indirectly from Claims 1, 3, 7, 12, 14, or 16 and include all of the limitations of the claim on which they depend. It is therefore respectfully submitted that Claims 2, 4 - 6, 8-10, 13, 15, and 17 –

18 are patentable over *Whitmarsh* for at least the reasons set forth herein with respect to the independent claim on which they depend.

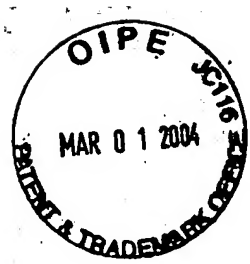
Furthermore, it is respectfully submitted that Claims 2, 4 - 6, 8-10, 13, 15, and 17 - 18 recite additional limitations that independently render them patentable over *Whitmarsh*. Given the fact that Claims 1, 3, 7, 12, 14, and 16 are allowable, dependent Claims 2, 4 - 6, 8-10, 13, 15, and 17 - 18 are also allowable, and arguments concerning the additional limitations of the dependent claims are not set forth at this time. Nevertheless, Applicants reserve the right to present such arguments at a later time in the prosecution of this application, if necessary.

#### **G. CONCLUSORY REMARKS for 35 U.S.C. § 102 AND CLAIMS 19-42**

In view of the foregoing, it is respectfully submitted that Claims 1-10 and 12-18 are patentable over *Whitmarsh*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-10 and 12-18 under 35 U.S.C. § 102(e) as being anticipated by *Whitmarsh* is respectfully requested. Additionally, because claims 19-42 have not yet been cancelled, Applicants note that, at least for the reasons stated above in respect of Claims 1-10 and 12-18, Claims 19-42 are also not anticipated by *Whitmarsh*.

#### **2. FINAL RESTRICTION REQUIREMENT**

Applicants note that the Examiner has made the requirement for restriction in this case final. However, Applicants maintain that the requirement for restriction is improper in this case. Therefore, Applicants have filed a Petition Under 37 CFR § 1.144 to request that the Honorable Commissioner for Patents review the final requirement for restriction that has been entered in this case.



3. **CONCLUSIONS AND MISCELLANEOUS**

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

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Date: February 25, 2004

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Non-Fee Amendment**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On February 25, 2004

By

  
Angelica Jaquez